

REMARKS

This election is in response to the Office Action, dated January 19, 2007 ("Office Action"). Claims 1-25 are pending. No new matter has been added. Examination of the claims in view of the ensuing remarks is respectfully requested.

In the Office Action, Examiner required election under 35 U.S.C. § 121 among aspects of the claimed invention depicted in Groups I, II, III, IV, and V. These Groups included the following:

- I. Claims 1-10 and 25 drawn to a method of detecting a cancer-associated transcript
- II. Claims 11-13 drawn to an expression vector
- III. Claims 14-20 drawn to an antibody
- IV. Claims 21-23 drawn to a method of detecting a cancer cell
- V. Claim 24 drawn to a method of identifying a compound that modulates a cancer-associated polypeptide

Examiner further contended that the Groups I to V contain claims generic to several distinct nucleotide sequences, all of which are referenced in claims 1, 11, 14, and 24.

Applicants hereby elect the embodiment of the instant invention including the inventive antibody described in Group III for prosecution on the merits. This election reads on claims 14-20. Applicants further hereby elect the species of epithelial membrane protein-1 as noted in Table 1A. All of the claims are readable thereon. Applicants reserve the right to pursue the claims drawn to the non-elected embodiments of the present invention in one or more divisional applications.

The foregoing election notwithstanding, Applicants respectfully traverse the restriction requirement and submit that it is improper. Examiner cites to 35 U.S.C. § 121 as the basis for the restriction requirement; however, this section permits restriction only

when the inventions are independent or distinct, and there is a serious burden on the Examiner. MPEP § 803.

Applicants respectfully assert that the claims in Groups I to V are directed to the expression profiles of nucleic acids, polypeptides, or antibodies thereto that are involved in cancer; and the use of these expression profiles and compositions in the diagnosis, prognosis, and therapy of cancer, or the detection of agents and/or targets that inhibit cancer. Accordingly applicants respectfully submit that a search of the prior art with respect to the groups of inventions identified by the Examiner would not constitute an undue burden. Without a serious burden, restriction is improper.

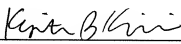
In addition, Applicants respectfully traverse Examiner's requirement of restriction to one of several distinct nucleotide sequences, all of which are referenced in claims 1, 11, 14, and 24 because the nucleotide sequences identified are all sequences of genes that exhibit increased or decreased expression in ZD1839 resistant cancer samples. Particularly, the identified sequences are involved in prostate cancer, small cell lung cancer, breast cancer, glioblastoma, cervical cancer, colon cancer, head and neck cancer, renal cell carcinoma, and pancreatic cancer. In addition, at least several of these sequences, i.e., up to 10, should be included in the instant application per the Patent Office Commissioner's Directive.

For the foregoing reasons, Applicants respectfully request that Examiner withdraw the restriction requirement as between Groups I, II, III, IV and V; and as between one of several distinct nucleotide sequences; and respectfully request further, favorable action on the merits.

All of the claims in the application are believed to be allowable. Favorable consideration and a Notice of Allowance are earnestly solicited. If for any reason Examiner finds the application other than in condition for allowance, Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213)

633-6800 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,
Daniel AFAR *et al.*
DAVIS WRIGHT TREMAINE LLP

By 
Kristin B. Kosinski
Registration No. 45,599

865 South Figueroa Street, Suite 2400
Los Angeles, CA 90017-2566
Phone: (213) 633-6800
Facsimile: (213) 633-6899